

## **REMARKS**

### **I. General**

Claims 1-19, 21-28, 30-34 and 36-46 are pending in the application. Claims 1-19, 21-22, 33-34 and 36-46 stand rejected under 35 U.S.C. § 101. Claims 1-4, 7-8, 12-13, 16, 23-24, 31-34 and 37-38 stand rejected under 35 U.S.C. § 102. Claims 5-6, 9-11, 14-15, 17-19, 21-22, 25-28, 30, 36 and 39-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant thanks the Examiner for the indication of allowability for claims 5-6, 9-11, 14-15, 17-19, 21-22, 25-28, 30, 36 and 39-46. Applicant hereby traverses the outstanding objections and rejections, and request reconsideration and withdrawal in light of the amendments and remarks contained herein.

Claims 1 and 33 are amended in accordance with the agreements reached on September 23, 2005 in a telephone interview with the Examiner, as described below. Claims 2-19 and 21-22 are amended to be consistent with the amendment to claim 1.

### **II. Applicant's Record Under M.P.E.P. § 713.04 of Interview with the Examiner**

Applicant's attorneys appreciate the Examiners' time and consideration in conducting the telephone interview of September 23, 2005. Applicant respectfully submits the following record of the telephone interview under M.P.E.P. § 713.04.

The following persons participated in the interview: Examiner Richard Woo and Applicant's Attorneys R. Ross Viguet (reg# 42,203) and Kelce Wilson (reg# 50,289).

Claim 1 was discussed regarding both the U.S.C. § 101 rejection and the U.S.C. § 102 rejection. An agreement was reached that amending claim 1 to be a method claim would overcome the U.S.C. § 101 rejection. A further agreement was reached that amending claim 1 to more clearly recite the invention would distinguish claim 1 from the cited art.

Claim 23 was discussed regarding the rejection over the cited art. An agreement was reached that claim 23 is allowable over the applied art in its present form.

Claim 33 was discussed regarding both the U.S.C. § 101 rejection and the U.S.C. § 102 rejection. An agreement was reached that amending claim 33 to include language clarifying that the program was executed would overcome the U.S.C. § 101 rejection. A further agreement was reached that amending claim 33 to more clearly recite the invention would distinguish claim 33 from the cited art.

In view of the telephone interview of September 23, 2005, Applicant hereby presents amended claims 1 and 33 for the Examiner's consideration.

### **III. Improper Finality**

Applicant respectfully asserts that the finality of the Office Action mailed July 14, 2005, wherein claim 23 remains rejected under 35 U.S.C. § 102(e) over Dietrich, is improper. In light of the Examiner's agreement that claim 23 should be allowable during the telephone interview of September 23, 2005, Applicant respectfully requests, pursuant to M.P.E.P. § 706.07(c), that the Examiner reconsider the final status of the Office Action and withdraw the finality of the rejection pursuant to M.P.E.P. § 706.07(d).

### **IV. Rejections under 35 U.S.C. § 101**

Claims 1-19, 21-22, 33-34 and 36-46 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 1 is amended as discussed in the telephone interview of September 23, 2005. Claim 1 now recites "A method of printing a data stream being presented to a printer, ... said method comprising ..." Accordingly, Applicant respectfully requests that the 35 U.S.C. § 101 rejection of claim 1 be withdrawn.

Claim 33 is amended as discussed in the telephone interview of September 23, 2005. Claim 33 now recites "A computer program product, embodied on a computer-readable medium, for use ... when executed ..." Accordingly, Applicant respectfully requests that the 35 U.S.C. § 101 rejection of claim 33 be withdrawn.

The 35 U.S.C. § 101 rejections of claims 2-19, 21-22, 34 and 36-46 result from their dependence from claims 1 and 33. Applicant asserts that claims 1 and 33 are patentable over the 35 U.S.C. § 101 rejection of record, and therefore requests that the 35 U.S.C. § 101 rejections of claims 2-19, 21-22, 34 and 36-46 be withdrawn.

**V. Rejections under 35 U.S.C. § 102**

Claims 1-4, 7-8, 12-13, 16, 23-24, 31-34 and 37-38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,401,943 to Dietrich et al. ("Dietrich").

In order to anticipate a claim, however, the reference must teach every element of the claim. M.P.E.P. § 2131. Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Applicant traverses these rejections and asserts that the 35 U.S.C. § 102 rejections of record do not satisfy these requirements and that the claims are allowable for, at least, the reasons stated below.

**A. Independent Claims 1, 23 and 33**

Claim 1 now recites "A method of printing a data stream ... comprising: abstracting at least a portion of said data bits from said data stream; ... and creating, from said abstracted data, a separate data stream for controlling the printing of said postage indicia." Dietrich does not disclose at least this aspect of claim 1. That is, Dietrich does not disclose abstracting a data stream that is being presented to a printer.

Instead, Dietrich discloses using a hardware "read-write module," which directly transmits to either a bookkeeping means or a "special address printer" separately. Dietrich, Figure 1 and column 3, lines 1-5 and 42-43. No details or suggestions are provided in Dietrich concerning "abstracting" either the data sent to the bookkeeping means or the special address printer in order to create a separate data stream.

Thus, Applicant respectfully asserts that Dietrich does not meet the claim as required under 35 U.S.C. § 102. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 1 and assert that claim 1 is allowable for, at least, the reason stated above.

Claim 23 recites, “sending a data stream to a printing device [and] reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to printing of documents.” Dietrich does not disclose at least this aspect of claim 23. That is, Dietrich does not disclose reviewing a data stream that is being sent to a printing device and creating therefrom a separate data stream for controlling additional functions with respect to printing.

Instead, Dietrich discloses using a hardware “read-write module,” which directly transmits to either a bookkeeping means or a “special address printer” separately. Dietrich, column 3, lines 1-5 and 42-43. No details or suggestions are provided in Dietrich concerning “reviewing” either the data sent to the bookkeeping means or the special address printer in order to create a separate data stream.

Thus, Applicant respectfully asserts that Dietrich does not meet the claim as required under 35 U.S.C. § 102. Accordingly, in light of the agreement reached during the telephone interview of September 23, 2005, and the reason given above, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 23 and assert that claim 23 is allowable.

Claim 33 recites, “an abstracting program operable for reviewing said data stream [being directed to a general purpose printer] to obtain therefrom a separate data stream for controlling additional printing operations.” Dietrich does not disclose at least this aspect of claim 33. That is, Dietrich does not disclose an abstracting program for reviewing a data stream that is being sent to a general purpose printer.

Instead, Dietrich discloses using a hardware “read-write module,” which directly transmits to either a bookkeeping means or a “special address printer” separately. Dietrich, column 3, lines 1-5 and 42-43. No details or suggestions are provided in Dietrich concerning

“an abstracting program ... reviewing” either the data sent to the bookkeeping means or the special address printer in order to create a separate data stream.

Thus, Applicant respectfully asserts that Dietrich does not meet the claim as required under 35 U.S.C. § 102. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 33 and assert that claim 33 is allowable for, at least, the reason stated above.

### **B. Dependent Claims**

Dependent claims 2-4, 7-8, 12-13, 16, 24, 31-32, 34 and 37-38 depend from a respective one of base claims 1, 23 and 33. The dependent claims each inherit all the limitations of their respective base claims. As shown above, Dietrich does not anticipate base claims 1, 23 or 33. Applicant asserts that these dependent claims are patentable for, at least, the reasons set forth above with respect to the base claims 1, 23 and 33. Accordingly, Applicant requests the Examiner withdraw the U.S.C. § 102(e) rejection of claims 2-4, 7-8, 12-13, 16, 24, 31-32, 34 and 37-38. Moreover, these dependent claims set forth additional features and limitations not disclosed by Dietrich.

For example, claim 4 recites, in part, “said at least one additional function further comprises a dialog box for allowing options from a user.” The Office Action states that “any personal computer inherently must have the user input interface.” Applicant traverses this rejection for at least two reasons.

Simply having a dialog box in an application is insufficient to meet the express limitations of the claim. Claim 4 requires abstracted data to be used in controlling a dialog box for allowing options from a user. Nothing in the statement of record regarding applications generally having dialog boxes is sufficient to anticipate the limitations of claim 4.

Moreover, the rejection of record is insufficient to establish inherency with respect to a dialog box. The M.P.E.P. states, “[t]he fact that a certain characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” Instead, “the examiner must provide a basis in fact and/or technical reasoning

to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112. Dietrich discloses an automated printing system – without mentioning any need for user input. Therefore, a dialog box for allowing options from a user does not necessarily flow from the teachings of Dietrich.

Claim 37 recites, in part, “said computer product is operable on said data stream coming from a general purpose computing device.” Dietrich does not disclose operating on a data stream coming from a general purpose computing device, but rather the output of an “INFORMATION CARRIER,” such as a chip card, and a “READ WRITE DEVICE” that is separate device from a general purpose computing device. See Dietrich, column 3, lines 45-49 disclosing that a personal computer requires a “read-write module” to be attached in order to read from the “information carrier.”

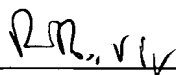
## **VI. Conclusion**

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P016US/10106022 from which the undersigned is authorized to draw.

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Respectfully submitted,

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